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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/824,525	04/15/2004	Yuji Kanome	03500.018076	6590
5514 7590 06/23/2008 FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112				
EXAMINER				
MCCLEIN, GERALD				
ART UNIT		PAPER NUMBER		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/824,525

Applicant(s)

KANOME ET AL.

Examiner

GERALD W. MCCLAIN

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 February 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 and 18-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 and 18-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

The amendment filed 4 February 2008 has been entered.

Claim Objections

Applicant is advised that should claim 1 be found allowable, claim 19 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, *despite a slight difference in wording*, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Rejections - 35 USC § 102

Claims 1 and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Trask, et al. (U.S. 5,116,034) ("Trask").

Claims 1 and 19: first stacking portion (26); second stacking portion (34); base member (20); tray (34); guide groove (54, 50, and 52); recording means (column 1, line 7); supplying roller (60).

Claim Rejections - 35 USC § 103

Claims 1-11 and 19-20, as understood by the Examiner, are rejected under 35 U.S.C. 103(a) as being unpatentable over Hewlett-Packard OfficeJet 600 Series Device

("HPOJ"; see "Examiner's Exhibit A" in the Office Action dated 12 March 2007) in view of Trask. HPOJ discloses:

Claims 1, 2, and 19: first stacking portion (3B; see the attached "Examiner's Exhibit A", page 3, letter B); second stacking portion (3C); base member (structure that connects 3C to 3B); (NOTE: in lines 7-10, the conditional phrases ("when") are construed such that they do not occur.)

Claims 1, 2, and 19: supplying roller (NOTE: there is implicitly a roller provided in HPOJ; either the first stacking portion or the second stacking portion is supplied by the supplying roller, but not necessarily both);

Claims 3 and 4: sheet supplying route blocking means (2D); an end portion of the sheet (4D); a sheet supplying route (3G);

Claim 5: a regulating portion (24);

Claim 6: second stacking portion (3C);

Claim 7: guide means (2C);

Claims 8: a shape protruding on the upstream side (2C);

Claims 9 and 10: cover means (3H);

Claims 11: regulating means (3J);

Claims 20: an inkjet type (5B).

HPOJ does not *directly* show a tray with a guide groove.

Trask shows a similar device having a tray with a guide groove (34 with 54, 50, and 52) for the purpose of provide an improved, automatic, envelope/sheet feed mechanism (column 1, lines 48-50). Therefore, it would have been obvious to a person

having ordinary skill in the art at the time the invention to modify HPOJ as taught by Trask and include Trask's similar device having a tray with a guide groove for the purpose of provide an improved, automatic, envelope/sheet feed mechanism.

Claims 1 and 12, as understood by the Examiner, are rejected under 35 U.S.C. 103(a) as being unpatentable over Jang (U.S. 6,315,280) in view of Trask. Jang discloses:

Claim 1: first stacking portion (21); second stacking portion (11); supplying roller (31); base member (structure that connects 11 to 21);

Claim 12: a final limit forward portion (53); a protruded portion (24).
Jang does not *directly* show a tray with a guide groove.

Trask shows a similar device having a tray with a guide groove (34 with 54, 50, and 52) for the purpose of provide an improved, automatic, envelope/sheet feed mechanism (column 1, lines 48-50). Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention to modify Jang as taught by Trask and include Trask's similar device having a tray with a guide groove for the purpose of provide an improved, automatic, envelope/sheet feed mechanism.

Claims 13, as understood by the Examiner, is rejected under 35 U.S.C. 103(a) as being unpatentable over HPOJ in view of Trask and further in view of Jang and

Watanabe, et al (U.S. 5,109,236) ("Watanabe"). HPOJ teaches all the limitations of the claim as discussed above. HPOJ does not directly show a sheet type discriminating sensor or a tray position detecting sensor.

Watanabe shows said sheet type discriminating sensor (1, 2) for the purpose of determining the type of the sheets (entire abstract). Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention to modify HPOJ as taught by Watanabe and include Watanabe's index sheet type discriminating sensor for the purpose of determining the type of the sheets.

In addition, Jang shows a tray position detecting sensor for sensing whether documents are loaded (abstract, line 4). Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention to modify HPOJ as taught by Jang and include Jang's tray position detecting sensor for sensing whether documents are loaded.

Claims 14-16, as understood by the Examiner, are rejected under 35 U.S.C. 103(a) as being unpatentable over HPOJ in view of Trask. HPOJ teaches all the limitations of the claims as discussed above. HPOJ does not directly show an index on the first stacking portion as a line or a character.

HPOJ shows said index on the first stacking means as a line or a character for the purpose of indicating the size of the sheet (3E). Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention to modify

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HPOJ as taught by HPOJ and include HPOJ's index as a line or character on the second stacking means for the purpose of indicating the size of the sheet.

Claims 18, as understood by the Examiner, is rejected under 35 U.S.C. 103(a) as being unpatentable over HPOJ in view of Trask and further in view of Teo, et al (U.S. 6,942,211) ("Teo"). HPOJ teaches all the limitations of the claims as discussed above. HPOJ does not directly show a cover member or a sub cover member.

Teo shows said cover member (108) and sub cover member (120) for the purpose of folding up out of the way when necessary (column 2, line 52). Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention to modify HPOJ as taught by Teo and include Teo's cover member and sub cover member for the purpose of folding up out of the way when necessary.

Response to Arguments

Applicant's arguments filed 4 February 2008 have been fully considered but they are not persuasive.

[1] Trask et al. does not teach or suggest a supply roller that supplies a sheet while in contact with a recording surface of the sheet stacked in the first stacking portion, or a recording surface of the sheet stacked in the second stacking portion. [2] Moreover, Trask et al. does not teach or suggest that aspect of Applicants' invention which provides structure for enabling for different types of sheets to be supplied by the same feed roller by moving the second stacking portion in relation to the first stacking portion. ...

... However, this device does not contain or disclose that [3] such second stacking portion be detachable from [sic] and attachable to the first stacking portion, or that [4] tray of the second stacking portion move in the sheet supplying direction.

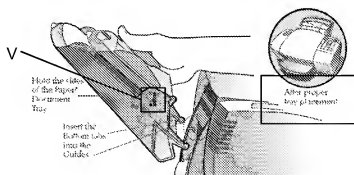
[5] Jiang does not teach or suggest a second stacking portion arranged to be detachable from and attachable to the first stacking portion or [6] that the tray of the second stacking portion move the sheets in the sheet supplying direction.

Regarding [1], roller 60 supplies sheets from trays 26 and 34 (see Fig. 7).

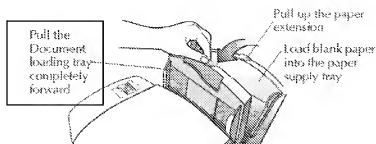
Regarding [2], see MPEP § 2115, "Expressions relating the apparatus to contents thereof during an intended operation are of no significance in determining patentability of the apparatus claim." Moreover, Trask "provides structure" that is capable of feeding different size sheets.

Regarding [3] and [5], it is the examiner's position that the apparatus disclosed in HPOJ and Jang, respectively, is inherently put together during its initial assembly, and inherently can be taken apart, e.g. for maintenance or repair. Alternatively, the structures can be broken off or forcibly removed. Moreover, MPEP § 2114, states "while features of an apparatus may be recited either structurally or functionally, claims directed to >an< apparatus must be distinguished from the prior art in terms of structure rather than function. See MPEP § 2114.

Regarding [4], note in the figures below (HPOJ) that the tray moves in groove V. Part of this movement is in the sheet supplying direction.



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Regarding [6], Examiner notes that tray 11 of Jang allows sheets to be moved in the sheet supplying direction. Roller 31 supplies the sheets from trays 11 and 21.

Conclusion

Applicant's amendment (Clams 1 and 19) necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **GERALD W. MCCLAIN** whose telephone number is

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(571)272-7803. The examiner can normally be reached on Monday through Friday from 7:30 a.m. to 4:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick H. Mackey can be reached on (571) 272-6916. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Gerald W. McClain
Examiner
Art Unit 3653

/Patrick H. Mackey/
Supervisory Patent Examiner, Art
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